

Application No.: 10/601,072
Filing Date: June 19, 2003

REMARKS

Applicants wish to thank Examiner Lei Yao and Supervisory Patent Examiner Shanon Foley for the time and courtesy extended during the telephonic interview conducted on October 18, 2007.

Claims 15, 17-22, 24-28 and 92-121 are currently pending and presented for examination. Claims 1-14, 16, 23 and 29-91 are currently canceled without prejudice or disclaimer. Applicants reserve their right to pursue any or all of the canceled subject matter in one or more continuing applications.

Claims 15, 24-28 and 95-98 are currently amended. Support for the amendments to these claims can be found throughout the claims and specification as originally filed. For example, support for the amendments to claims 15, 24-28 and 95-98 can be found at page 78, lines 21-31, at page 114, line 24 to page 115, line 26, in the claims as originally filed and elsewhere throughout the specification. Accordingly, the amendments to claims 15, 24-28 and 95-98 do not constitute new matter.

Claims 99-121 are newly added. Support for these new claims can be found throughout the claims and specification as originally filed. For example, support for new claims 99-121 can be found at page 179, line 20 to page 183, line 17, at Figure 19, at Figures 20A-C and elsewhere throughout the specification. Accordingly, new claims 99-121 do not constitute new matter.

Response to Notice to Comply

The Examiner asserts that Applicants have not complied with the requirements for patent applications containing nucleotide sequence and/or amino acid sequence disclosures. In particular, the Examiner asserts that certain figures contain nucleotide and/or amino acid sequences that are not assigned a Sequence Identification Number (SEQ ID NO).

Applicants maintain that they are in full compliance with the requirements for patent applications containing nucleotide sequence and/or amino acid sequence disclosures. In particular, every sequence depicted in the drawings referenced by the Examiner is assigned a SEQ ID NO in the Brief Description of Drawings section of the instant application. As set forth in section 2422.02 of the M.P.E.P., sequence assignments for sequences appearing in figures can be made either in the figure or in the Brief Description of Drawing corresponding to the figure.

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In the instant application, Applicants have elected to assign SEQ ID NOs in the Brief Description of Drawings section. Accordingly, Applicants respectfully request that the Examiner withdraw the Notice to Comply attached to the Office Action issued April 23, 2007.

Rejection of claims 15-28 and 92-98 under 35 U.S.C. § 112, first paragraph (written description)

The Examiner rejects claims 15-28 and 92-98 under 35 U.S.C. § 112, first paragraph as allegedly not being adequately supported by the instant specification. In particular, the Examiner asserts the specification does not “provide a teaching that all these polypeptides of THAP could bind to chemokine and inhibit the activity of the chemokine.”

Applicants maintain that independent claim 15 and each of the claims dependent thereon are adequately described. However, in order to expedite the allowance of the instant claim set, Applicants have agreed to amend independent claim 15 to recite SEQ ID NO: 3, a chemokine-binding domain of SEQ ID NO: 3, a polypeptide having at least 95% sequence identity to SEQ ID NO: 3 and a polypeptide having at least 95% sequence identity to a chemokine-binding domain of SEQ ID NO: 3. As agreed during the telephonic interview of October 18, 2007, such amendment would overcome the written description rejection of record.

In view of the foregoing remarks and amendments, Applicants respectfully request that the Examiner withdraw the rejection of claims 15-28 and 92-98 as lacking adequate description under 35 U.S.C. § 112, first paragraph.

Rejection of claims 15-28 and 92-98 under 35 U.S.C. § 112, first paragraph (enablement)

The Examiner rejects claims 15-28 and 92-98 under 35 U.S.C. § 112, first paragraph as allegedly not being enabled by the instant specification. In particular, the Examiner asserts that although the specification teaches binding of the THAP1 chemokine-binding domain to certain chemokines, “the disclosed binding property between THAP1 and some of the chemokines does not convince one skilled in the art that the binding would result in the inhibition of chemokine functions.”

During the telephonic interview of October 18, 2007, the Examiner and her supervisor stated that demonstration of the binding of a chemokine-binding domain of SEQ ID NO: 3 to various chemokines, does not necessarily show that contacting a chemokine with a chemokine-

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binding domain of SEQ ID NO: 3 would be sufficient to inhibit chemokine activity. The Examiner's supervisor stated, however, that a declaration showing that a chemokine-binding domain of SEQ ID NO: 3 could indeed inhibit chemokine activity would be favorably considered.

Applicants maintain that independent claim 15 and each of the claims dependent thereon are fully enabled by the specification. However, in order to expedite the allowance of the instant claim set, Applicants have agreed to amend independent claim 15 to recite SEQ ID NO: 3, a chemokine-binding domain of SEQ ID NO: 3, a polypeptide having at least 95% sequence identity to SEQ ID NO: 3 and a polypeptide having at least 95% sequence identity to a chemokine-binding domain of SEQ ID NO: 3.

In addition to the foregoing amendment, as suggested by Supervisory Patent Examiner Foley, Applicants submit herewith a Declaration under 37 C.F.R. § 1.132 of co-inventor Dr. Jean-Philippe Girard, which shows that amended claim 15 is fully enabled. In particular, as stated in item 5 of the declaration, both *in vitro* and *in vivo* experiments to determine inhibition of chemokine activity were preformed using the chemokine-binding domain of SEQ ID NO: 3 and pro-inflammatory chemokines. The first experiment, item 6 of the declaration, shows that the chemokine binding domain of SEQ ID NO: 3 possesses the ability to inhibit white blood cell chemotaxis mediated by chemokine CCL5 *in vitro*. The second experiment, item 7 of the declaration, shows that the chemokine binding domain of SEQ ID NO: 3 possesses the ability to inhibit chemokine-induced cell recruitment mediated by chemokines CCL5 and CCL1 *in vivo*. The third experiment, item 8 of the declaration, shows that the chemokine binding domain of SEQ ID NO: 3 possesses the ability to inhibit the progression of chemokine-induced rheumatoid arthritis (an inflammatory condition mediated by chemokines) *in vivo*. These experimental results show that contacting a chemokine with a chemokine-binding domain of SEQ ID NO: 3 results in the inhibition of chemokine activity. Accordingly, Applicants submit these data demonstrate that the subject matter recited in the above-rejected claims is fully enabled.

In view of the foregoing remarks and amendments, Applicants respectfully request that the Examiner withdraw the rejection of claims 15-28 and 92-98 as not enabled under 35 U.S.C. § 112, first paragraph.

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No Disclaimers or Disavowals

Although the present communication may include alterations to the application or claims, or characterizations of claim scope or referenced art, the Applicants are not conceding in this application that previously pending claims are not patentable over the cited references. Rather, any alterations or characterizations are being made to facilitate expeditious prosecution of this application. The Applicants reserve the right to pursue at a later date any previously pending or other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by any prior prosecution. Accordingly, reviewers of this or any parent, child or related prosecution history shall not reasonably infer that the Applicants have made any disclaimers or disavowals of any subject matter supported by the present application.

Co-Pending Applications of Assignee

Applicant wishes to draw the Examiner's attention to the following co-pending applications of the present application's assignee.

Serial Number	Title	Filed
10/317,832	NOVEL DEATH ASSOCIATED PROTEINS, AND THAP1 AND PAR4 PATHWAYS IN APOPTOSIS CONTROL	10-Dec-2002
11/417,317	CHEMOKINE-BINDING PROTEIN AND METHODS OF USE	03-May-2006
11/360,450	ACTIVITY OF THAP-FAMILY CHEMOKINE-BINDING DOMAINS	22-Feb-2006
11/418270	ACTIVITY OF THAP-FAMILY CHEMOKINE-BINDING DOMAINS	03-May-2006
11/417,954	COMPOSITIONS OF THAP-FAMILY CHEMOKINE BINDING DOMAINS	03-May-2006
11/418,410	COMPOSITIONS OF THAP-FAMILY CHEMOKINE BINDING DOMAINS	03-May-2006
11/417,953	NUCLEIC ACIDS ENCODING COMPOSITIONS OF THAP-FAMILY CHEMOKINE BINDING DOMAINS	03-May-2006

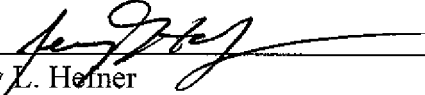
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Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: October 30, 2007

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